



PATENT
2832-0166P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: Soon Bog KWON et al. Conf. No.: 9828
Application No.: 10/724,219 Group: 1775
Filed: December 1, 2003 Examiner: C. Lam
For: TAPE SUBSTRATE AND METHOD FOR FABRICATING THE
SAME

PETITION UNDER 37 CFR §1.181 AND §1.144

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

November 1, 2005

Sir:

Applicants hereby petition the Commissioner to exercise supervisory authority and require the Examiner to withdraw the outstanding restriction requirement and examine all pending claims, including claims 7-12, which have been withdrawn from consideration.

This petition is contingent on the Examiner's denial of Applicants' request for reconsideration of the restriction requirement and withdrawal of claims 7-12 from consideration in the Reply under 37 CFR §1.111 filed on even date herewith.

No Petition Fee is Required

Because this petition is filed under 37 CFR §1.181, no petition fee is due.

Background

A restriction requirement was made on September 28, 2004 between Group I, claims 1-6 drawn to a tape substrate classified in Class 428, subclass 209 and Group II, claims 7-12, drawn to a method of producing a tape substrate, classified in Class 427, subclasses 96+.

On October 28, 2005, Applicants filed a Response to the Restriction Requirement, electing Group I for prosecution, with traverse.

On January 10, 2005, a first Office Action on the merits was mailed, which withdrew claims 7-12 from consideration without treating the merits of Applicants' traversal, and which acted on the merits of claims 1-6.

On May 9, 2005, Applicants filed an Amendment under 37 CFR §1.111, responding to the merits of the first Office Action on the merits and continuing to traverse the restriction requirement.

On August 1, 2005, a second Office Action on the merits was mailed, which adhered to the restriction requirement, and continued to withdraw claims 7-12 from consideration.

Remarks

Initially, Applicants note, based on the background information presented above, that reconsideration has been requested of the Examiner's restriction requirement and the Examiner's withdrawal of claims 7-12 from consideration, and the request for reconsideration has been denied by the Examiner. Thus, the petition is ripe for consideration per 37 CFR §1.144.

Applicants respectfully point out that the restriction requirement is improper, withdrawal of claims 7-12 from consideration was, and is, improper, and that the Commissioner should require the Examiner to withdraw the restriction requirement and act on the merits of all pending claims, including withdrawn claims 7-12, for at least the following reasons.

Firstly, no Office Action addresses Applicant's extensive arguments presented on pages 2-4 of the Response to Restriction Requirement filed on October 28, 2005, thereby violating the explicit requirements of MPEP Sections 821.01 and 707.07(f) to address the merits of Applicants' arguments. Because of this failure to address Applicants' extensive arguments traversing the restriction requirement, the restriction requirement must be withdrawn, prosecution reopened, and claims 7-12 examined on their merits.

The Examiner completely fails to respond to this argument, which was previously presented in the Amendment filed on May 9, 2005, thereby denying

Applicants the substantive and procedural due process to which they are entitled under the Administrative Procedures Act and MPEP §707.07(a). See in this regard, In re Zurko, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000), and MPEP §707.07(a). For this reason alone, the restriction requirement must be withdrawn.

Secondly, the Examiner continues to fail to demonstrate that inventions I and II are distinct because the product, as claimed, recites, among other features (1) a buffer layer plated on the copper foil pattern; and (2) a tin layer plated on the barrier layer. The Examiner does not provide any objective factual evidence that the allegedly materially different process forms a barrier layer plated on a copper foil pattern and a tin layer plated on a barrier layer. All that the Examiner's allegedly materially different process achieves is a "spray coated" tin material on a barrier material, and a sputter coated barrier material on a copper material. This is not the claimed invention. Furthermore, a "transfer of a decalcomania" is not a materially different product than what is recited in claim 1. It is just another name for using what is recited in claim 1. Thus, the process, as claimed, has not been demonstrated to be used to make a different product than what is claimed.

The Examiner completely fails to respond to this argument, which was previously presented in the Amendment filed on May 9, 2005, thereby denying Applicants the substantive and procedural due process to which they are

entitled under the Administrative Procedures Act and MPEP §707.07(a). See in this regard, In re Zurko, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000), and MPEP §707.07(a). For this reason alone, the restriction requirement must be withdrawn.

The response that is made to Applicants' traversal of the restriction requirement is that the method claims involve heating the barrier layer and the tin layer and would require a further search and is burdensome to the Examiner.

Applicants respectfully submit that whether a serious administrative burden is placed on an Examiner, discussed in MPEP §803, is only one factor to consider in justifying making a restriction requirement. In this regard, please note MPEP §803, which points out that there are two criteria for a proper restriction requirement, one of which is that the invention must be independent or distinct as claimed, the other being a serious administrative burden on the Examiner.

To justify this restriction requirement between the claimed product (tape substrate) and process of making the product, the Examiner must fully comply with the provisions of MPEP §806.05(f).

In other words, in order to justify this restriction requirement between a product and a method of making a product, the Examiner has to show (1) a serious administrative burden on the Examiner and (2) that either (A) the process as claimed is not an obvious process of making the product and the

process as claimed can be used to make other and different products; or (B) the product as claimed can be made by a materially different process. See MPEP §806.05(f). Moreover, as stated in MPEP §803, the Examiner must give reasons to support her conclusions.

The Examiner has not made such a showing, and Applicants have presented detailed reasons why the Examiner has not made such a showing, arguments that have been improperly not addressed in the outstanding Office Action or the previous Office Action. Moreover, the reason given to support the conclusion that examination of the method steps is burdensome is only that there would be a further search required. However, in this instance, the Office Action has not pointed out what additional features and subject matter will have to be searched for method claims 7-12 in addition to what has to be searched for claims 1-6 and 13.

Accordingly, the restriction requirement is improper and claims 7-12 should not have been withdrawn from consideration.

Conclusion

For the aforementioned reasons, the Honorable Commissioner is respectfully requested to require the restriction requirement to be withdrawn, and prosecution be reopened with respect to claims 7-12, which should be examined on their merits.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: *Esther H. Chong #40953*
Scott L. Lowe
Reg. No.: 41,458

SLL/RJW:gf *me*

P.O. Box 747
Falls Church, Virginia 22040-0747
Telephone: (703) 205-8000